UNITED STATES PATENT AND TRADEMARK OFFICE

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10/616,676	07/10/2003	Daniel Charles Birkestrand	ROC920030147US1	2588

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-21,23 and 45* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-21,23 and 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *04/06/2008; 06/12/2008; 08/07/2008*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Information Disclosure Statement

An additional information disclosure statement(s) (IDS) submitted on 04/06/2008,

06/12/2008, and 08/07/2008 are being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

Claims 19-21, 23 and 45 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Circenis et al. (US 7,146,496, filed Jan. 23, 2003, referred hereinafter

as "Circenis").

In regard to claims 19, Circenis discloses a computer-implemented method for

providing metered capacity of at least one temporary resource on demand in a

computer system that includes a plurality of logical partitions, the method comprising the

steps of:

- receiving an enablement code from a user of the computer system (see

    column 5, line 44, disclosing receiving a "codeword" from vendor), wherein

the enablement code includes a specified resource-time (see column 12, lines

1-10, disclosing that preferably the codeword encodes information including

"the amount of temporary capacity granted", i.e., "a specified resource-time");

- determining whether the enablement code is valid (see column 8, lines 1-4,

  disclosing user must type in a valid codeword);

- *if* the enablement code is valid, performing the steps of:

  o enabling the at least one resource for metered operation by a selected

    logical partition (see column 5 line 60 - column 6, line 45, disclosing how

    "ICOD components" can be activated and subsequently metered; see also

    column 8, lines 5-20, disclosing "the ICOD computer system is

    implemented as a partitionable computer system");

  o determining whether the enabled resource is shared, and if so, metering

    actual usage of the at least one resource by the selected logical partition

    (see column 6, lines 14-45, disclosing tracking consumption of temporary

    capacity) above a predetermined non-zero threshold that specifies

    allowable usage of the at least one resource by the selected logical

    partition (see column 9, lines 15-35, disclosing "a negative temporary

    capacity balance.").

While Circenis does not explicitly disclose:

- *billing* for the actual usage of the at least one resource,

Circenis does disclose debiting a user's account which could arguably be construed to

mean "billing for actual usage." (See column 6, lines 46-60, disclosing debiting

consumption from the current temporary capacity balance.) Moreover, it would have been obvious to one of ordinary skill in the art at the time of the invention to generate a bill rather than debit a prepaid account because these steps are notoriously old and well-known to be interchangeable depending on the preferences of the service provider and the customer.

In regard to certain elements stated in claim 19, Applicant is reminded that optional or conditional elements (e.g., claim 19 which recites "if the enablement code is valid") do not narrow the claims because they can always be omitted. *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006). "Language that <u>suggests or makes optional</u> but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim of claim limitation." MPEP §2106(II)(C) [Emphasis in original].

If a positive recitation is desired and if Applicant(s)' original specification supports such an amendment, the Examiner respectfully suggests amending the claim to recite, e.g., "after validating the enablement code, performing the steps of . . ."

<u>In regard to claims 20 and 21</u>, Circenis additionally discloses wherein the generated bill is for metered resource-time that represents actual use of the at least one resource (see column 6) and deducting metered resource-time from a prepaid resource-time (see column 6, lines 46-60, and disclosing debiting consumption from the current temporary capacity balance).

In regard to claims 20 and 21, Applicant is reminded that optional or conditional elements (e.g., claim 19 which recites "if the enablement code is valid") do not narrow the claims because they can always be omitted. *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006). "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim of claim limitation." MPEP §2106(II)(C) [Emphasis in original].

Because claims 20 and 21 depend on claim 19 which recites a conditional limitation, the elements of these claims are also conditional and therefore fail to narrow the scope of the claims. If a positive recitation is desired and if Applicant(s)' original specification supports such an amendment, the Examiner respectfully suggests amending claim 19 to recite, e.g., "after validating the enablement code, performing the steps of . . ."

In regard to claim 23, Circenis additionally discloses the step of disabling the at least one resource when the metered actual usage of the at least one resource exceeds a specified resource-time. (See column 7, disclosing "deactivation.")

In regard to claim 45, Circenis discloses a computer-implemented method for providing metered capacity of at least one temporary resource on demand in a computer system that includes a plurality of logical partitions, the method comprising the steps of:

- requesting an enablement code from a resource provider for the computer

  system (see column 5, lines 35-60, disclosing activating the inactive ICOD

  components at the request of the user);

- receiving the enablement code from the resource provider (see column 5, line

  44, disclosing receiving a "codeword" from vendor), wherein the enablement

  code includes a specified resource-time for a selected resource (see column

  12, lines 1-10, disclosing that preferably the codeword encodes information

  including "the amount of temporary capacity granted", i.e., "a specified

  resource-time");

- enabling the selected resource for use (see column 5 line 60 - column 6, line

  45, disclosing how "ICOD components" can be activated and subsequently

  metered);

- *if* the selected resource is dedicated to one of the plurality of logical partitions,

  performing the steps of:

  o starting a meter timer (see column 6, disclosing "the temporary capacity

    balance may be tracked using a universal unit");

  o using the selected resource until a time to bill occurs (see column 6, lines

    37-45, disclosing "periodically . . . tak[ing] an inventory of the number of

    components currently active on the ICOD system);

  o sending a record of metered usage to the resource provider based on

    value of the meter timer (see column 6, lines 46-60, disclosing the ICOD

    software agent may inform the user the current rate of consumption); and

- *if* the selected resource is not dedicated to one of the plurality of logical

  partitions and is shared between first and second logical partitions (see

  column 8, disclosing "the ICOD computer system [may be] implemented as a

  partitionable computer system"), performing the above-mentioned steps for

  each logical partition (i.e., using a selected resource without charge until

  metered use exceeds a first predetermined non-zero threshold, metering use

  of the selected resource, and sending a record of metered usage).

Circenis does not explicitly disclose when either condition is met,

- the resource provider *sending a bill* for metered usage of the selected

  resource to a customer, or the resource provider *sending a bill* for metered

  usage of the selected resource that excess the second predetermined non-

  zero threshold to the customer.

However, Circenis does disclose debiting a user's account for metered usage of

the selected resource to a customer. (See column 6.) It would have been obvious to

one of ordinary skill in the art at the time of the invention to send a bill rather than debit

a prepaid account because these steps are notoriously old and well-known to be

interchangeable depending on the preferences of the service provider and the customer

(i.e., design choice).

Applicant(s) are reminded that optional or conditional elements (e.g., claim 45

which recites "*if* the selected resource is dedicated to one of the plurality of logical

partitions, performing the steps of") do not narrow the claims because they can always

be omitted. *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006).

"Language that <u>suggests or makes optional</u> but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim of claim limitation." MPEP §2106(II)(C) [Emphasis in original].

If a positive recitation is desired and if Applicant(s)' original specification supports such an amendment, the Examiner respectfully suggests amending the claim to recite, e.g., "after the selected resource is dedicated to one of the plurality of logical partitions, performing the steps of . . ."

Response to Arguments

Applicant's arguments filed 04/06/2008 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 112

Previously claim 30 was rejected under 35 U.S.C. 112, second paragraph. However, because claim 30 has been cancelled the previous rejection is withdrawn.

Claim Rejections - 35 USC § 101

Previously claims 28-35 are rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. However, because claims 28-35 have been canceled, the previous rejection is withdrawn.

Claim Rejections - 35 USC § 103

The rejections under 35 USC §103 have been traversed under two rationales.

First applicant argues, in reference to claims 19, that Circenis does not teach a

codeword which includes a specified resource-time. However, Circenis discloses "the

codeword furnished by the portal encodes information," including "the amount of

temporarily capacity granted." (See column 12, lines 1-10). The amount of temporary

capacity granted is analogous to a specified resource-time.   Thus, Applicant's first

argument is not persuasive.

> Secondly, Applicant argues that Circenis does not teach or suggest:
>
> determining whether the enabled resource is shared, and if so, metering
> actual usage of the at least one resource by the selected logical partition
> above predetermined non-zero threshold that specifies allowable usage of
> the at least one resource by the selected logical partition above the
> predetermined non-zero threshold.

First, it should be acknowledged that the above-captioned step is only performed

on condition that the enablement code is valid (i.e., "*if* the enablement code is valid,

performing the steps of . . .). Thus, the above-captioned step need not be disclosed by

the prior art reference in order for the prior art reference the fall within the metes and

bounds of the claimed invention (i.e., the condition may never be met).

Notwithstanding, Applicant specifically argues that Circenis does not disclose

"metering and billing for usage of a share resource above a predetermined non-zero

threshold that specifies allowable usage of the shared resource by the selected logical

partition."

It should be noted that "during patent examination, the claims are given the broadest reasonable interpretation consistent with the specification." MPEP §904.01 and §2111, citing *In re Morris*, 127 F3d 1048 (Fed. Cir. 1997). In addition, "limitations appearing in the specification but not recited in the claim should not be read into the claim. See MPEP §2106, citing *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003). Thus, under its broadest reasonable interpretation, "shared" can be construed to mean "provided access." Thus, based on such an interpretation, determining whether a resource is shared is analogous with determining whether a resource is accessible by the user. If the resource in Circenis is provided to the user (i.e., user submits a codeword for access), Circenis discloses that the resource is monitored for actual usage. (See column 6.) Furthermore, Circenis suggests that the ICOD computer system may be implemented as a partitionable computer system and even references a co-pending application entitled "Methods and Apparatus for Managing the Execution of a Task among a Plurality of Autonomous Processes". Lastly, Circenis discloses that the ICOD components are left activated so long as the temporary capacity balance is above some predefined threshold, e.g., "-20"). (See column 9.) Thus, the above-captioned element is nevertheless taught by the prior art reference.

Claim 45 merely repeats the previous steps using first and second logical partitions. Thus, the limitations of claim 45 do not further distinguish claimed invention from the prior art as logical partitions are contemplated by Circenis.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2004/0148511, Circenis et al. (Codeword-based auditing of computer systems and methods therefor)

US 2004/0199632, Romero et al. (Assembly and method for balancing processors in a partitioned server)

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT A. ZARE whose telephone number is (571)270-

3266. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00

p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Matt Gart can be reached on (571) 272-3955. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art
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August 12, 2008